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| 09/934,521 | 08/23/2001 | Yasushi Isami | TD-US000367 | 8144 |

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| EXAMINER |
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CHARIOUI, MOHAMED

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| ART UNIT | PAPER NUMBER |
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2857

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,521

Applicant(s)

ISAMI, YASUSHI

Examiner

Mohamed Charioui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the term "Applying the same" in page 60, line 6. It is unclear from the claim what "the same" refers to and what the Applicant intends to apply. Therefore, claim 8 is rendered indefinite.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the term "applying the same" in page 62, line 7. It is unclear from the claim what "the same" refers to and what the Applicant intends to apply. Therefore, claim 13 is rendered indefinite.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the term "transmits the same" in page 64, line 7. It is unclear from the claim what "the same" refers to and what the Applicant intends to transmit. Therefore, claim 18 is rendered indefinite.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the term “transmits the same” in page 64, line 11. It is unclear from the claim what “the same” refers to and what the Applicant intends to transmit. Therefore, claim 19 is rendered indefinite.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the term “transmits the same” in page 64, line 15. It is unclear from the claim what “the same” refers to and what the Applicant intends to transmit. Therefore, claim 20 is rendered indefinite.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the term “outputs the same” in page 66, line 5. It is unclear from the claim what “the same” refers to and what the Applicant intends to output. Therefore, claim 25 is rendered indefinite.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 recites the term "outputs the same" in page 66, line 20. It is unclear from the claim what "the same" refers to and what the Applicant intends to output. Therefore, claim 27 is rendered indefinite.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-12 and 15-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Winkelman.

As per claims 1, 3, 15-17, 22 and 23, Winkelman teaches a measurement step of calculating measurement data by means of a measurement device for a subject's in vivo test and/or in vitro test (see col. 6, lines 30-35 and col. 7, lines 10-20), a first transmission step of transmitting the measurement data from the measurement device to an analysis device via a network, a first receiving step of receiving the measurement data by the analysis device, an analysis step of analyzing the measurement data by the analysis device to obtain analytical data (see col. 8, lines 27-40; col. 13, line 55 to col. 14, line 25; and col. 10, lines 50-62), a second transmission step of transmitting the analytical data from the analysis device, via the network, to the measurement device, and a second receiving step of receiving the analytical data by the measurement device

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(col. 8, lines 27-40; col. 13, line 55 to col. 14, line 25; col. 16, lines 35-39; and col. 10, lines 50-62).

As per claims 5 and 10, Winkelman teaches an analytical data producing device (see col. 13, lines 3-27); connection means for connecting, via a network (see col. 8, lines 27-40; col. 13, line 55 to col. 14, line 25; and col. 10, lines 50-62), a measurement device that conducts measurements for a subject's in vivo test and/or in vitro test and calculates measurement data (see col. 6, lines 30-35 and col. 7, lines 10-20); receiving means for receiving the measurement data from the measurement device via the connection means (see col. 8, lines 27-40; col. 13, line 55 to col. 14, line 25; and col. 10, lines 50-62), analysis means for conducting an analysis of the measurement data, and calculating analytical data (see col. 13, lines 3-62), and transmission means for transmitting, via the connection means, the analytical data to the measurement device (see col. 8, lines 27-40; col. 13, line 55 to col. 14, line 25; and col. 10, lines 50-62).

As per claims 2, 4, 6, 11, 18 and 21, Winkelman further teaches that the transmission step includes a step of associating a communication address of the measurement device with the measurement data (see col. 11, line 57 to col. 12, line 16 and col.13, lines 3-62).

As per claims 7, 12, 19, 20, 25 and 27, Winkelman further teaches that the receiving means further receives identification information and test items for the subject that are associated with the measurement data, and the transmission means transmits the identification information of the subject and the test items associated with the measurement data (see col. 14, lines 13-26).

As per claims 24, 26, 28 and 29, Winkelman further teaches an output device comprising connection means for connecting a measurement device that conducts measurements for a subject's in vivo test and/or in vitro test and calculates measurement data (see col. 13, lines 3-62), receiving means for receiving the measurement data from the measurement device via the connection means (see col. 12, lines 17-38), and output means for outputting the measurement data (see col. 13, lines 3-62).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winkelman in view of Pritchard.

Winkelman teaches the system as stated above except for the determination means for determining items billed to the manager of the measurement device based on the contract conditions and the usage results.

Pritchard teaches this feature (see col. 8, lines 11-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Pritchard's teaching into Winkelman's invention because it would have provided a contract means for compensating the hospital/facility for the analysis services provided, and determined if such a contract would cover all of the expenses of

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the analysis services. Therefore, the system would notify the user if there were additional fees that need to be paid when the cost of services performed can not be covered by the contract limits.

Prior art

4. The prior art made record and not relied upon is considered pertinent to applicant's disclosure:

Hefti ['795] discloses bio-assay device and test system for detecting molecular binding events.

Thomas et al. ['413] disclose reliable noninvasive measurement of blood gases.

Aryev et al. [012] disclose automated laboratory software architecture.

Bui et al. ['727] disclose method and apparatus for providing patient care.

Russo et al. ['949] disclose apparatus for monitoring and/or controlling a medical device.

Yee et al. ['723] disclose system and method for self-identifying a portable information device to a computing unit.

James Heller et al. disclose an in-vivo test system for electrochemical sensors.

J.E. Chomas et al. disclose correlation analysis of received echoes from contrast agents in-vitro and in-vivo.

Contact information

5. Any inquiry concerning this communication from examiner should be directed to Mohamed Charioui whose telephone number is 703 605-4362. The examiner can normally be reached Monday to Friday 9 am to 6 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached at 703 308-1677. The fax phone number for the organization where this application is assigned is 703 305-3431.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose number is 703 308-0956.

Mohamed Charioui

7/21/03


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800